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REMARKS

Claims 1 and 3-5 are under consideration. The indication that claims 3-5 define allowable subject matter is noted with appreciation.

Claims 2 and 6-20 are canceled without prejudice in favor of a divisional application.

Claims 1 and 3-5 are amended to incorporate the Examiner's helpful comments and to obviate the claim rejections based on 35 U.S.C. 112, second paragraph. As suggested by the Examiner, the claimed association of shafts and gears has been further characterized by adjectives and names.

Claim 3 also has been rewritten in independent form so as to place claim 3, as well as claims 4 and 5 dependent thereon, in condition for allowance. Inasmuch as there are only two pending independent claims, no additional claim fee is due.

The Examiner's objection to the drawings is not warranted. Tube 14 is shown in FIG. 1 (upper right portion). Slot 75 is shown in FIG. 17 in parts 19 and 21 of compound spur gear 16.

The rejection of claim 1 under 35 U.S.C. 103(a) as unpatentable over the Applicant's own U.S. Patent No. 6,065,212 in view of U.S. Patent No. 5,881,616 to Nanzai is not warranted, and is hereby traversed.

The mechanisms shown clearly are different and the respective gear trains as well as their operation are different. Nanzai teaches the use of two separate pinions 11 and 15 on two separate shafts to rotate main gear 7 and cam mounting gear 8, each having no center axis. See, for example, col. 3, lines 57-65. The spur gear arrangement shown by Lazarevic has a common axis and is not even close to that shown by Nanzai. Accordingly, there is no valid, rational basis why one of ordinary skill would have even attempted to look to Nanzai when seeking to improve upon the pipe cutter of Lazarevic. Inasmuch as Nanzai is earlier in point of time than Lazarevic, Nanzai could not have been referring to the Lazarevic pipe cutter when describing drawbacks of "conventional pipe cutting apparatus" in col. 1, at lines 30-37. No valid rationale has been advanced by the Examiner as to why one of ordinary skill would have looked to Nanzai when seeking to improve Lazarevic's pipe cutter.

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It is well established that it is the Examiner's burden to establish *prima facie* obviousness. See In re Rijckaert, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). The Examiner's burden of proof is manifold. The Examiner must demonstrate that the cited prior art includes "a suggestion of all the elements in a claim." CFMT, Inc. v. Yieldup Int'l Corp., 68 U.S.P.Q.2d 1333, 1342 (Fed. Cir. 2003). The Examiner must also provide evidence that would demonstrate "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." KSR, 550 U.S. at 418, 82 U.S.P.Q.2d at 1396.

To reiterate, to establish a *prima facie* case of obviousness, the following requirements must be satisfied. First, "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." KSR, 550 U.S. at 418-419, 82 U.S.P.Q.2d at 1396. Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. Amgen Inc. v. Chugai Pharm. Co., 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. In re Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). These requirements are not satisfied in this case.

As stated by the Supreme Court, "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent

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reason to combine the known elements in the fashion claimed by the patent at issue.” KSR 550 U.S. at 418, 82 U.S.P.Q.2d at 1396. “To facilitate review, this analysis should be made explicit.” Id. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In re Kahn, 441 F.3d 977, 988 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006). Here such articulated reasoning is lacking.

The obviousness rejection of claim 1, as amended, should be withdrawn. Early passing of this application to issue is solicited.

Respectfully submitted,

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By Talivaldis Cepuritis
Talivaldis Cepuritis, Reg. No. 20,818

OLSON & CEPURITIS, LTD.
20 N. Wacker Drive
36th Floor
Chicago, Illinois 60606
(312) 580-1180

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT AND RESPONSE UNDER RULE III is being transmitted by facsimile transmission to Fax No. (571) 273-8300 on August 12, 2009.

Talivaldis Cepuritis
Talivaldis Cepuritis (Reg. No. 20,818)